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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,818	02/24/2000	Scott Harvey Demsky	AUS990886US1	7815

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EXAMINER

BROWN, TIMOTHY M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/513,818	DEMSKY ET AL.
Examiner	Art Unit	
Tim Brown	3625	

-- The MAILING DATE of this communication app ears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

## Disposition of Claims

4)  Claim(s) 1-7 and 11-13 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-7 and 11-13 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some \* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_ .  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ . 6)  Other: \_\_\_\_ .

## **DETAILED ACTION**

1. This Non-Final Office Action is responsive to the Amendment submitted October 1, 2002 and the Supplemental Amendment submitted December 9, 2002.

### ***Status of Claims***

2. Claims 3, 4, 10 and 11 have been amended according to the instructions in the Amendment. Claims 1, 2, 9 and 13 have been amended pursuant to the Supplemental Amendment. Claims 8 and 14 have been cancelled.

### ***Claim Objections***

3. The Objections made in the Office Action are withdrawn in response to the Amendment.

### ***Claim Rejections - 35 USC § 112***

4. The rejections made under 35 U.S.C. §112 in the Office Action have been withdrawn in response to the Amendment.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

**5. Claims 1-3, 5-7, 9, 10, 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Fergerson et al. (US 5,966,697).**

Regarding claim 1, Fergerson et al. teach a method for carrying out, over a communication network of interconnecting computers, electronic transactions between a plurality of merchants using at least one server computer and at least one buyer using a client computer, comprising:

displaying, at the client computer, a separate representation for each item selected by the buyer from at least two different merchants wherein each separate representation has an associated one of a plurality of selectable states, and wherein a certain one of the plurality of selectable states indicates that the buyer desires to purchase a desired item from a first merchant if a previous transaction which bought another item from a second merchant can be canceled (col. 2, lines 32-41; col. 8, lines 29-34; col. 9, lines 42-46; col. 13, lines 60-67; and Figs. 9A and 9F); and

displaying an indication of the one associated selectable state with each displayed separate representation (col. 2, lines 32-41; col. 8, lines 29-34; col. 9, lines 42-46; col. 13, lines 28-38 and 60-67; and Figs. 9A and 9F); and

selecting one of the displayed separate representations to have a selectable associated state that indicates that the buyer desires to purchase a desired item from a first merchant if a previous transaction which bought another item from a second merchant can be cancelled (Id.).

Regarding claim 2, Fergerson et al. teach a method for carrying out, over a communication network of interconnecting computers, electronic transactions between

a plurality of merchants using at least one server computer and at least one buyer using a client computer, comprising:

enabling the client computer to display a separate representation for each item selected by the buyer from at least two different merchants wherein each representation has one of a plurality of associated states at a given instance in time (col. 2, lines 32-36; col. 8, lines 29-34; col. 13, lines 60-67; and Figs. 9A and 9F); and

displaying an indication of the one associated selectable state with each displayed separate representation (col. 2, lines 32-41; col. 8, lines 29-34; col. 9, lines 42-46; col. 13, lines 28-38 and 60-67; and Figs. 9A and 9F); and

selecting, by the buyer, one of the displayed separate representations to have a selectable associated state that indicates that the buyer desires to purchase the desired item if a previous transaction which bought another item from another merchant can be canceled (col. 2, lines 22-26; and col. 8, lines 1-21).

Regarding claim 3, Ferguson et al. teach sending, from the client, to the certain merchant an identification of the other merchant and the other item, and receiving a notification that the previous transaction is canceled (col. 2, lines 31-41).

Regarding claim 5, Ferguson et al. teach changing the selected state to a different state, upon notification of the cancellation, wherein the different state provides an indication of one of the following: a) the buyer desires to put the desired item on hold for a time to consider buying the desired item, and b) the buyer has bought the desired item (col. 11, lines 30-34).

Regarding claim 6, Fergerson et al. inherently teach providing the other item with another representation wherein the associated state is changed, upon receipt of the notification, to indicate that the previous transaction is canceled. Fergerson et al. disclose that a user's order is displayed both before and after a user has deleted unwanted items from the order list (col. 9, lines 42-46; and col. 10, lines 1-13). Therefore, the cancellation of a previously ordered item is indicated by its absence in the modified order list. As a result, Fergerson et al. inherently teach providing the other item with an other representation wherein the associated state is changed, upon receipt of the notification, to indicate that the previous transaction is canceled.

Regarding claim 7, Fergerson et al. teach providing the other item with a displayed other representation on the client computer which becomes automatically deleted, upon receipt of the notification indicating that the previous transaction is canceled (col. 9, lines 42-46; and col. 10, lines 1-13).

Regarding claim 9, Fergerson et al. teach a client computer system enabled to communicate over a network with at least one server computer system for carrying out electronic transactions for a buyer using the client computer system for the purchase of items from a plurality of merchants using the at least one server computer system, the client computer system comprising:

a storage device having a set of instructions (Fig. 2; col. 2, lines 32-41; col. 8, lines 29-43; col. 9, lines 42-46; col. 10, lines 1-27; and col. 13, lines 29-39);

a processing unit, connected to the storage device, wherein the processing unit executes the set of instructions for

- i. displaying a separate representation for each item selected by the buyer from at least two different merchants wherein each separate representation has an association of a plurality of selectable associated states at a given instance in time and wherein a certain one of the plurality of selectable associated states indicates that the buyer desires to purchase a desired item from a first merchant if a previous transaction which bought another item from a second merchant can be canceled;
- ii. displaying an indication of the one associated selectable state with each displayed separate representation; and
- iii. executing a selection, by the buyer, of a desired item from a certain merchant causing one of the displayed separate representations to have a selectable associated state that indicates the buyer desires to purchase the desired item if a previous transaction which bought another item from another merchant can be canceled (Fig. 2; col. 2, lines 32-41; col. 8, lines 29-43; col. 9, lines 42-46; col. 10, lines 1-27; and col. 13, lines 29-39).

Regarding claim 10, Ferguson et al. teach a means for sending, from the client computer, to the certain merchant an identification of the other merchant and the other item, and means for receiving a notification that the previous transaction is canceled (col. 2, lines 31-41).

Regarding claim 12, Ferguson et al. teach a means for changing the selected state to a different state, upon notification of the cancellation, wherein the different state provides an indication of one of the following: a) the buyer desires to put the desired

item on hold for a time to consider buying the desired item, and b) the buyer has bought the desired item (col. 11, lines 30-34).

Claim 13 is rejected as discussed under claim 1 above as claim 13 pertains to a computer program for accomplishing the method of claim 1.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (US 5,966,697) in view of Walker et al. (US 6,249,772) ( Walker '772).**

Regarding claim 4, Ferguson et al. and Walker et al. teach all the limitations discussed under claim 1 above. Ferguson et al. and Walker et al. do not specifically teach a method for carrying out electronic transactions between a plurality of merchants and at least one buyer wherein the selected associated state causes an indication to be sent from the client to the certain merchant to lock specific data associated with the desired item from being accessible by a different client during a period that the representation for the desired item has the selected associated state. However, Walker '772 discloses reserving an item at a local store after a user has negotiated a price for the item over a communication network (col. 10, lines 35-64). At the time of the applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Ferguson et al. and Walker et al. to include the teachings of Walker '772 because a method for carrying out electronic transactions between a plurality of

merchants and at least one buyer wherein the selected associated state causes an indication to be sent from the client to the certain merchant to lock specific data associated with the desired item from being accessible by a different client during a period that the representation for the desired item has the selected associated state would enable a merchant to hold an item for a buyer so that the item will not be sold while the buyer decides whether to purchase the item.

Claim 11 is rejected as discussed under claim 4 above as claim 11 pertains to a system for accomplishing the method of claim 4.

***Response to Arguments***

**Claims 1-3, 5-10 and 12-14**

8. Applicants argue Fergerson et al. (US 5,966,697) ("Fergerson") does not teach a state that indicates a buyer desires to select an item if she can cancel a transaction with a different merchant. (Amendment, p. 8). The Examiner disagrees.

First, Fergerson teaches a state that indicates a buyer desires to select an item. Fergerson discloses an electronic shopping cart that permits users to select items for purchase from plurality of merchants (col. 2, lines 16-42). The user selects items for purchase by activating the shopping cart icon featured in Fig. 9A. *After the items have been selected for purchase, they are displayed* in the shopping cart table of Fig. 9B. Thus, Fergerson teaches a state that indicates whether a buyer desires to purchase an item.

Second, Fergerson teaches that the buyer's decision to purchase an item at checkout may be conditioned on the ability to cancel a previous transaction. For

example, after a buyer has selected items from a number of merchants, Fergerson's order review function permits the customer to add and remove items from the shopping cart (col. 9, lines 42-47; and 10, lines 1-15). Some of these items may be the same, but selected from different merchants. Thus, a customer may decide to remove an item, if she has selected the item from another merchant who offers it for a lower price. If the customer was obligated to purchase the more expensive item removed, or had already purchased it, she would not indicate a desire to buy the cheaper item. Thus, Fergerson discloses a state that indicates a state that indicates a buyer desires to select an item if she can cancel a transaction with a different merchant.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the references is to enable a user to condition buying an alternate good on the user's ability to cancel the purchase of a previously selected good. Thus, a user could substitute a previously purchased good, with a more desirable good without being liable for two transactions.

9. Applicants argue Fergerson fails to teach sending from the client to the certain merchant an identification of the other merchant and the other item and receiving a

notification that the previous transaction is canceled. The Examiner disagrees. Fergerson generally provides that a customer may use a single shopping cart to shop at different merchants (Abstract). Fergerson further teaches that a customer's shopping data from a first merchant, may transferred to a second merchant (col. 2, lines 26-45; and col. 8, lines 28-42). Fergerson further teaches that "*at any time* the user may choose to see, edit and *delete items previously selected* regardless of which merchant the computer the user is currently accessing." (Col. 2, lines 38-40). Thus, a customer may cancel a transaction with a first merchant while the customer is accessing the first merchant. This information constitutes shopping data and Fergerson provides that shopping data may be transferred from a first merchant, to a second merchant. Therefore, Fergerson teaches sending from the client to the certain merchant an identification of the other merchant, the other item and a notification that the previous transaction is canceled

#### Claims 4 and 11

10. Applicants argue Walker et al. (US 5,794,207) ("Walker") teaches away from their invention by disclosing a central controller that sends a message to the local store that causes the local store to place a hold on the inventory item. (Amendment, p. 11). This argument is moot in view of the new grounds of rejection. However, the Examiner responds as follows.

Applicants point out Walker teaches away from their invention because their invention involves the step of "causing an indication to be sent from the client to the certain merchant's [sic]." (Id.). The Examiner disagrees. Walker discloses an online

purchasing system wherein a user may make an inventory reservation such that "the [user] is assured that he will actually receive the product . . ." (Col. 10, lines 35-45). Walker further provides the "reservations of goods *can* occur by having central controller 110 send a message to the selected local store . . ." (Col. 10, lines 46-48). Thus, the reservation message does not necessarily originate from the central controller. The reservation message could easily originate from user computer 102 in that user computer 102 is connected to the Internet (see Fig. 1). Therefore, Walker does not teach away from the claimed invention.

11. Applicants argue Walker et al. (US 6,249,772) ("Walker '772") does not teach or suggest "a select [sic] associated state indicating that the buyer desires to purchase the desired item if a previous transaction which bought another item from another merchant can be canceled . . ." (Amendment, p. 11). The Examiner submits this argument is moot in that Fergerson teaches this limitation as discussed under paragraph 4 above.

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (703) 305-1912. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703) 308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Tim Brown  
Examiner  
Art Unit 3625

TB  
December 13, 2002



MARY A. SMITH  
PRIMARY EXAMINER

## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

### **A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

### **A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.